

REMARKS

Status of the Claims

Claims 1, 2, 5-30 and 32-39 are pending in this application. Claim 4 has been canceled. No claims have been added. Claim 1 has been amended to correct an error in the amendments submitted on May 10, 2002. Claim 1 is amended to define the methods involved in the screening step of the claimed method. Support is found at page 1, line 4. Claims 37 and 38 have been amended to further define the biological screening method. Claim 39 has been amended to further define the analytical screening method. No new matter has been added by the above claim amendments.

Double Patenting

The Examiner objects to claim 5 as being a substantial duplicate of claim 4. Applicants delete claim 4. Thus, the rejection should be withdrawn.

Claim Objections

The Examiner objects to claims 4, 5 and 37-39 as being improper dependent claims because claim 5 does not further limit claim 4, and claims 38 and 39 allegedly do not further limit claim 37. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants cancel claim 4; thus, the objection to claim 4 should be withdrawn. Applicants respectfully disagree with the Examiner's objection to claims 38 and 39, particularly in light of the above claim amendments. Claim 37 is directed to further limiting the screening step to detect biological activity when interacting with microorganisms or enzymes. Claim 38 is narrower than claim 37 because the method of claim 38 excludes microorganisms and is directed to interaction with only enzymes. Moreover, claim 39 is dependent from claim 33. Claim 33 is directed to the screening method being an analytical screening method. Claim 39 is narrower than claim 33 because claim 39 requires that the analytical method used be detection of catalytic activity when the compound is interacting with a catalyst.

As such, Applicants submit that the scope of claim 38 is narrower than claim 37 and that the scope of claim 39 is narrower than claim 33. Thus, claims 38 and 39 are proper dependent claims and the objection should be withdrawn.

Rejections under 35 USC 112, second paragraph

The Examiner rejects claims 1, 2, 4-30 and 32-37 as indefinite. The Examiner objects to the phrase "said chemical reaction involving a reaction mixture including chemical reagents". Applicants amend the claims to delete the offensive phrase.

The Examiner also rejects claims 37-39 because allegedly all the steps of the process are not specifically recited. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that all the steps of the method are recited in independent claim 1 and further defined in the dependent claims 37 to 39. The invention involves three steps: (a) synthesis, (b) separation and (c) screening. Claims 37-39 further define the screening step. As such, Applicants submit that the rejection should be withdrawn.

Rejections under 35 USC 102(b)

The Examiner rejects claims 1, 4-10, 12, 21, 24-27 and 32-37 as anticipated by JP 03099264 (JP '264). Applicants traverse the rejection and respectfully request the withdrawal thereof.

JP '264 fails to disclose all the elements of the claimed method. JP '264 fails to disclose the screening step involving biological or biochemical methods. Furthermore, JP '264 fails to disclose a method where the screening step takes place in the same medium as the preceding steps. As such, the rejection should be withdrawn.

The Examiner also rejects claims 1, 4-10, 12, 21, 24-27 and 32-37 as anticipated by Frank. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Frank fails to disclose a method where synthesis, separation and screening take place in the same medium as with the present invention. Frank discloses the synthesis of certain peptides on a paper support. However, since the peptides are synthesized on the paper support, it is impossible to perform the separation step of the claimed method because the peptides are "immobilized" as they are anchored to the paper support. See page 9220, lines 16-18 of Frank. Furthermore, according to Frank, if the peptides are separated, the peptides are separated and are placed in a separate medium for screening. In conclusion, not only can Frank not separate the peptide in the same medium, but according to Frank, the screen step cannot be performed in the same medium.

As such, Applicants submit that Frank fails to disclose a method where the separation and screening steps take place in the same medium as the preceding synthesis step as recited in the present invention. Thus, the rejection should be withdrawn.

Rejections under 35 USC 103(a)

The Examiner rejects claims 2, 18 and 29-30 as obvious over JP '264 or Frank in view of Reed USP 5,332,665 (Reed '665).

Reed '665 fails to disclose or suggest a process where the separation and screening steps take place in the same medium as the preceding synthesis step. In view of this lack of disclosure, Applicants relying on the arguments above regarding JP '264 and

Frank, submit that the Examiner has failed to make a prima facie case of obviousness because the combination of the cited references fails to disclose or suggest all the elements of the claimed method. As such, one of ordinary skill in the art would not be motivated to make the claimed invention from the combination of the disclosures.

Pursuant to MPEP 2143 and *In re Vaeck*, the Examiner must establish that there is motivation within the cited references or in the field of art to combine the reference to arrive at the present invention. In the absence of such a teaching, Applicants submit that the rejection should be withdrawn for no prima facie case of obviousness.

Conclusion

As Applicants have addressed and overcome all objections and rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

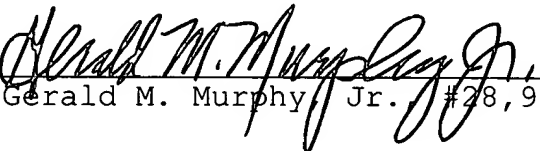
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 4 has been canceled.

The claims have been amended as follows:

1. (Amended) A method for preparing and screening a plurality of compounds, said compounds being handled in a bulk of a stationary phase, the method comprises the sequential steps of (a) synthesizing the compounds by a chemical reaction performed in the bulk of the [a] stationary phase, [said chemical reaction involving a reaction mixture including chemical reagents,] (b) separating the compounds [by biological or biochemical method] in the same bulk of the [a] stationary phase and (c) screening of the separated compounds in or on the same bulk of the stationary phase, wherein said screening involves biological or biochemical methods.

37. (Amended) A method according to claim 1, wherein the screening step involves [either] the detection of biological effects of a compound interacting with a microorganism or an enzyme.

38. (Amended) A method according to claim 37, wherein the screening step involves the detection of biological effects of a compound interacting with a microorganism.

39. (Amended) The method of claim 33, wherein the analytical method is detection of catalytic activity produced by the mutation of a compound and a catalyst by observed changes in absorption of light or detection of fluorescence due to a cleaved substrate.